

REMARKS

In the Office Action¹, the Examiner took the following actions:

objected to claims 13 and 27;

rejected claims 11, 13, 14, 25, 27, 28, and 29 under 35 U.S.C. § 112, second paragraph as being indefinite;

rejected claims 1-10, 15-24, and 29-38 under 35 U.S.C. § 103(a) as being unpatentable over group.yahoo.com (*Yahoo!*) in view of U.S. Patent No. 6,185,587 to Bernardo et al. ("*Bernardo*");

rejected claims 11, 25, and 39 under 35 U.S.C. § 103(a) as being unpatentable over *Yahoo!* in view of *Bernardo* and further in view of U.S. Patent Application Publication No. 2002/0087600 to Newbold ("*Newbold*"); and

rejected claims 12-14 and 26-28 under 35 U.S.C. § 103(a) as being unpatentable over *Yahoo!* in view of *Bernardo*, in view of *Newbold* and further in view of U.S. Patent No. 5,754,939 to Herz et al. ("*Herz*").

By the present amendment Applicant has amended the specification and claims 1, 11, 13, 14, 15, 25, 27, 28, 29, and 39. Claims 1-39 remain pending in this application.

I. Objection to claims 13 and 27

On page 2 of the Office Action, the Examiner objected to claims 13 and 27. In an effort to further prosecution, Applicant has amended claims 13 and 27. In view of the foregoing, Applicant respectfully requests reconsideration and withdrawal of the objection to claims 13 and 27.

¹ The Office Action contains a number of statements reflecting characterizations of the related art and the claims. Regardless of whether any such statement is identified herein, Applicant declines to automatically subscribe to any statement or characterization in the Office Action.

II. Rejection of claims 11, 13, 14, 25, 27, 28, and 39 under 35 U.S.C. §112, second paragraph

The Examiner rejected claims 11, 13, 14, 25, 27, 28, and 39, stating that the claims “fail to particularly point out and distinctly claim the subject matter which applicant regards as the invention.” See Office Action, page 2. Applicant respectfully traverses this rejection. However, to expedite prosecution, Applicant has amended claims 11, 13, 14, 25, 27, 28, and 39, thereby even more clearly claiming the subject matter which applicant regards as invention. Therefore, Applicant submits that claims 11, 13, 14, 25, 27, 28, and 39 fully meet the requirements of 35 U.S.C. § 112 and respectfully requests the Examiner to reconsider and withdraw the rejection of claims 11, 13, 14, 25, 27, 28, and 39 under 35 U.S.C. §112.

III. Rejection of claims 1-10, 15-24, and 29-38 under 35 U.S.C. § 103(a) as being unpatentable over *Yahoo!* in view of *Bernardo*

Applicant respectfully traverses the rejection of claims 1-10, 15-24, and 29-38 under 35 U.S.C. § 103(a) as being unpatentable over *Yahoo!* in view of *Bernardo*. A *prima facie* case of obviousness has not been established.

The key to supporting any rejection under 35 U.S.C. § 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious. Such an analysis should be made explicit and cannot be premised upon mere conclusory statements. See *M.P.E.P. § 2142, 8th Ed., Rev. 6 (Sept. 2007)*. “A conclusion of obviousness requires that the reference(s) relied upon be enabling in that it put the public in possession of the claimed invention.” *M.P.E.P. § 2145*. Furthermore, “[t]he mere fact that references can be combined or modified does not render the resultant

combination obvious unless the results would have been predictable to one of ordinary skill in the art” at the time the invention was made. *M.P.E.P. § 2143.01(III)*, *internal citation omitted*. Moreover, “[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” *M.P.E.P. § 2141.02(I)*, *internal citations omitted* (emphasis in original).

“[T]he framework for objective analysis for determining obviousness under 35 U.S.C. § 103(a) is stated in *Graham v. John Deere Co.*, 383 U.S. 1, 148 U.S.P.Q 459 (1966) . . . The factual inquiries . . . [include determining the scope and content of the prior art and] . . . [a]scertaining the difference between the claimed invention and the prior art.” *M.P.E.P. § 2141(II)*. Office personnel must explain why the difference(s) between the prior art and the claimed invention would have been obvious to one of ordinary skill in the art.” *M.P.E.P. § 2141(III)*.

Independent claim 1, recites a method of automatically building a community including “selecting a community template based on a primary interest, wherein the community template is selected before options associated with the community template are viewed by the members,” (emphases added). The applied prior art does not teach at least these elements of claim 1, and does not render claim 1 obvious.

The Examiner correctly states that “*Yahoo!* does not disclose using templates to automatically build its community of members.” See Office Action, page 4. The

Examiner relies on *Bernardo* to allegedly disclose these elements. However, this is not correct.

Bernardo discloses

“provid[ing] a tool for creating a Web site where the tool comprises a library of stored templates (including fields) associated with different options/features for a Web site, and various help documents relating to the options/features. The tool prompts a user of the tool to select desired options/features from a list of possible options/features. Based upon the option/features selected, the tool determines which of the stored templates (and fields) are to be used,” (col. 2, lines 58-66).

In another part of *Bernardo* it is explained that “[t]he tool provides several stored views to present the various options/features to the Web site creator so that the site creator may select the options/features desired for inclusion in the Web site,” (col. 6, lines 53-56). Thus, the tool taught by *Bernardo* presents views of different options/features of a template to a user and a template is selected based on the selection of options by the user. However, the selection in *Bernardo* does not constitute Applicant’s claimed “selecting,” which includes “selecting a community template based on a primary interest,” as recited in claim 1 (emphasis added), because the tool in *Bernardo* selects a template based on options and features selected by a user.

The Examiner alleges “it is obvious that if the website is directed to a specific interest, the templates would incorporate the interest when the features/options for the web site are selected by the user.” See Office Action, page 4. The Examiner’s allegation is incorrect. As noted above, according to *Bernardo*, templates are selected based on options selected by a user. Such a disclosure does not constitute “selecting a

community template based on a primary interest" (emphasis added), as recited in claim

1. Further, *Bernardo* teaches selecting templates after the user views and selects options/features associated with the template. This does not constitute the claimed "selecting a community template based on a primary interest, wherein the community template is selected before options associated with the community template are viewed by the members," because, at most, *Bernardo* teaches selecting templates after a user views and selects options associated with the template. There is no need or reason to modify the system of *Bernardo* for selecting templates "before options associated with the community template are viewed by the members." In view of the incorrect analysis of the prior art set above, the Examiner's conclusion of obviousness is not supported.

As discussed, "[i]n determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." *M.P.E.P.* § 2141.02(I), internal citations omitted (emphasis in original).

Here, no *prima facie* case of obviousness has been established for at least the reason that, in view of the mischaracterization of the references discussed above the Office Action has failed to properly determine the scope and content of the prior art and has accordingly failed to properly ascertain the difference between the prior art and the matter of claim 1. Moreover, regarding the differences that have been cited, no reason has been provided as to why one of ordinary skill in the art, at the time the invention was made, would modify *Yahoo!* or *Bernardo* to achieve the claimed combinations.

Moreover, the Office Action has not identified any predictability or reasonable expectation of success of such a modification.

Thus no *prima facie* case of obviousness has been established with respect to claim 1. Therefore, the Examiner should withdraw the rejection of claim 1 under 35 U.S.C. § 103(a).

Independent claims 15 and 29, though of different scope from claim 1, recite elements similar to those of claim 1 and are thus also allowable over *Yahoo!* and *Bernardo* for reasons similar to those presented above for claim 1. Claims 2-6, 8-10, 16-20, 22,24, 30-34, and 36-38 are also allowable at least due to their dependence from claims 1, 15, and 29. Reconsideration and withdrawal of the rejection under 35 U.S.C. § 103(a) is therefore respectfully requested and deemed appropriate.

IV. Rejection of claims 11, 25, and 39 under 35 U.S.C. § 103(a) as being unpatentable over of *Yahoo!* in view of *Bernardo* and further in view of *Newbold*

Applicant respectfully traverses the rejection of claims 11, 25, and 39 under 35 U.S.C. § 103(a) as being unpatentable over *Yahoo!* in view of *Bernardo* and further in view of *Newbold*. A *prima facie* case of obviousness has not been established with respect to these claims.

Claims 11, 25, and 39 depend from claims 1, 15, and 29 and thus require all elements of claims 1, 15, and 29. As discussed above, *Yahoo!* and *Bernardo* do not teach or suggest each and every element of claims 1, 15, and 29.

Moreover, *Newbold* fails to remedy the above-noted deficiencies of *Yahoo!* and *Bernardo* with respect to independent claims 1, 15, and 29. For example, *Newbold* fails

to teach, suggest, or render obvious among other things “selecting a community template based on a primary interest, wherein the community template is selected before options associated with the community template are viewed by the members,” (emphases added) as recited in claims 1, 15, and 29, and required by claims 11, 25, and 39.

For at least these, reasons the Office Action has failed to clearly articulate a reason why *Yahoo!*, *Bernardo* and *Newbold* would render the claimed combination obvious to one of ordinary skill in the art. Thus no *prima facie* case of obviousness has been established with respect to claims 11, 25, and 39.

Accordingly, for at least the above-noted reasons, Applicant requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 11, 25, and 39.

V. Rejection of claims 12-14 and 26-28 under 35 U.S.C. § 103(a) as being unpatentable over of *Yahoo!* in view of *Bernando*, in view of *Newbold*, and further in view of *Herz*

Applicant respectfully traverses the rejection of claims 12-14 and 26-28 under 35 U.S.C. § 103(a) as being unpatentable over *Yahoo!* in view of *Bernando*, in view of *Newbold*, and further in view of *Herz*. A *prima facie* case of obviousness has not been established with respect to these claims.

Claims 12-14 and 26-28 depend from claims 1 and 15 and thus requires all elements of claims 1 and 15. As discussed above, *Yahoo!*, *Bernardo*, and *Newbold* do not teach or suggest each and every element of claims 1 and 15.

Moreover, *Herz* fails to remedy the above-noted deficiencies of *Yahoo!*, *Bernardo*, and *Newbold* with respect to independent claims 1 and 15. For example, *Newbold* fails

to teach, suggest, or render obvious among other things "selecting a community template based on a primary interest, wherein the community template is selected before options associated with the community template are viewed by the members," (emphases added) as recited in claims 1 and 15 and required by claims 12-14 and 26-28.

For at least these reasons, the Office Action has failed to clearly articulate a reason why *Yahoo!*, *Bernardo*, *Newbold* and *Herz* would render the claimed combination obvious to one of ordinary skill in the art. Thus no *prima facie* case of obviousness has been established with respect to claims 12-14 and 26-28.

Accordingly, for at least the above-noted reasons, Applicant requests withdrawal of the 35 U.S.C. § 103(a) rejection of claims 12-14 and 26-28.

CONCLUSION

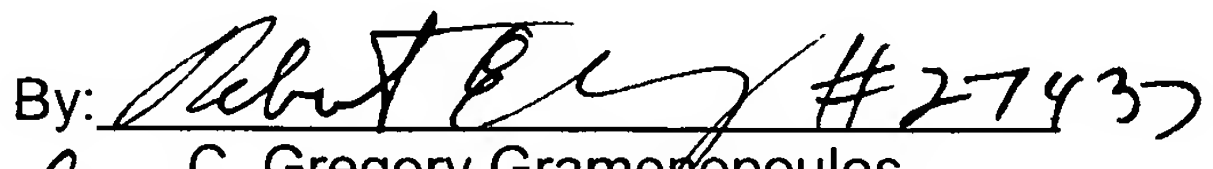
In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge any additional required fees to our deposit account 06-0916.

Respectfully submitted,

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Dated: March 20, 2008

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